

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 09/851,071
Filed : May 8, 2001
Page 2

REMARKS

Claims 17, 19, 20 and 35 are pending in the subject application. No claim has been added, canceled or amended herein. Accordingly, claims 17, 19, 20 and 35 are still pending and under examination.

The Claimed Invention

Claims 17, 19, 20 and 35 provide a method for evaluating the ability of an agent to inhibit tumor cell spreading. This method comprises (a) admixing with cell culture media an effective amount of an agent known to inhibit the interaction between a tumor cell and an extracellular matrix molecule selected from the group consisting of an amphoterin, a cadherin, an integrin and a hyaluronic acid, wherein the agent is selected from the group consisting of a peptide, a peptidomimetic, a nucleic acid, a synthetic organic molecule, an inorganic molecule, a carbohydrate, a lipid, and a fragment of an antibody, (b) contacting a tumor cell in cell culture with media from step (a), (c) determining the amount of spreading of the tumor cell in the cell culture and (d) comparing the amount of spreading of the tumor cell determined in step (c) with the amount determined in the absence of the agent, thus evaluating the ability of the agent to inhibit tumor cell spreading.

Rejection under 35 U.S.C. §103(a)

In the Final Office Action, the Examiner rejected claims 17, 19, 20 and 35 under 35 U.S.C. §103(a) as allegedly obvious over Gehlsen, et al. (JCB 106:925-930, 1988) ("Gehlsen") in view of Seftor, et

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 09/851,071
Filed : May 8, 2001
Page 3

al. (PNAS 89:1557-1561, 1992) ("Seftor").

Applicants respectfully traverse the rejection of claims 17, 19, 20 and 35.

In order to find the claimed method obvious over Gehlsen in view of Seftor, the prior art references, in combination, must teach or suggest all the elements thereof, and create both a motive to combine and a reasonable expectation of success. Gehlsen and Seftor fail to do this.

Claims 17, 19, 20 and 25 are discussed above. Again, the method of claim 17, upon which claims 19, 20 and 35 depend, comprises, in part, the element of *admixing with cell culture media an effective amount of an agent known to inhibit the interaction between a tumor cell and an extracellular matrix molecule selected from the group consisting of an amphoterin, a cadherin, an integrin and a hyaluronic acid.*

Applicants note that neither Gehlsen nor Seftor teaches or suggests this element, i.e., *admixing cell culture media with an effective amount of an agent known to inhibit the interaction between a tumor cell and an extracellular matrix molecule selected from the group consisting of an amphoterin, a cadherin, an integrin and a hyaluronic acid.* In contrast, Gehlsen, for example, teaches the identification of agents that inhibit tumor cell spreading by inhibiting the interaction between tumor cells and certain other extracellular matrix molecules (e.g. fibronectin and vitronectin), *none of which is recited in the instant claims.*

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 09/851,071
Filed : May 8, 2001
Page 4

Applicants further note that Seftor, which teaches the use of certain anti-integrin antibodies, does not teach the admixing of any such antibody with *cell culture medium*. The Examiner has not shown otherwise.

Thus, the cited references, in combination, fail to teach or suggest all elements of the claimed method. Consequently, they also fail to create a motive to combine or a reasonable expectation of success.

Accordingly, applicants maintain that claims 17, 19, 20 and 35 are not obvious over Gehlsen in view Seftor, and therefore satisfy the requirements of 35 U.S.C. §103(a).

Supplemental Information Disclosure Statement

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants would like to direct the Examiner's attention to the following reference. The applicable fee set forth in 37 C.F.R. §1.17(p) is \$180.00, and a check for that amount is enclosed.

This Information Disclosure Statement is submitted as a supplement to the Information Disclosure Statement filed December 30, 2004. The applicants direct the Examiner's attention to the following reference which is listed on the enclosed PTO-1449 form attached hereto as **Exhibit A**.

1. U.S. Patent Application No. 09/689,469, for Ann Marie Schmidt and David Stern, filed October 12, 2000 (**Exhibit B**).

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 09/851,071
Filed : May 8, 2001
Page 5

Applicants request that the Examiner review the reference and make it of record in the subject application.

Summary

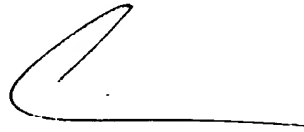
For the reasons set forth hereinabove, applicants respectfully request that all the claims of this application be allowed, and that the application proceed to issuance.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorneys invite the Examiner to telephone them at the number provided below.

Applicants : Ann Marie Schmidt, et al.
U.S. Serial No: 09/851,071
Filed : May 8, 2001
Page 6

No fee, other than the \$180.00 fee set forth in 37 C.F.R. §1.17(p) for filing an Information Disclosure Statement, is deemed necessary in connection with the filing of this Communication. However, if any additional fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



John P. White
Registration No. 28,678
Alan J. Morrison
Registration No. 37,399
Attorneys for Applicants
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, New York 10036
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop AE
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Alan J. Morrison
Reg. No. 37,399

Date

4/28/01